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OFFICE OF PETITIONS

In re Patent of Yamanaka et al.:

Patent No. 7,873,128 :  
Issue Date: January 18, 2011 : DECISION ON REQUEST  
Application No. 10/773,610 : FOR RECONSIDERATION OF  
Filed: February 6, 2004 : PATENT TERM ADJUSTMENT  
Docket No. 17475US02 :  
:

This is a decision on the petition filed on March 9, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand six hundred forty-one (1641) days.

The petition under 37 CFR 1.705(d) is **dismissed**.

Patentees dispute the Office's determination of the length of reduction associated with the filing of a Rule 312 amendment on September 30, 2010 and the Office's calculation of the three years to issue guarantee of 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) (hereinafter, "B delay").

It is undisputed that applicants filed a Rule 312 amendment on September 30, 2010, after the mailing of a notice of allowance on July 9, 2010. Patentees argue the length of reduction should be 70 days, rather than the presently accorded 71 days. The Office does not concur.

37 CFR 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

A notice of allowance was mailed on July 9, 2010. Pursuant to 37 CFR 1.704(c)(10), the Office properly entered a period of reduction of 71 days, counting the number of days in the period beginning on September 30, 2010, the date the Rule 312 amendment was filed, and ending on and including December 9, 2010, the date the Office mailed correspondence addressing the September 30, 2010 Rule 312 amendment. Accordingly, no change will be made to the 71 day reduction associated with the filing of a Rule 312 amendment on September 30, 2010.

In addition, the Office does not concur with patentees' assertion the period of B delay is 1040 days. The maximum period of B delay in this case is 1062 days. Unless a Request for Continued Examination ("RCE") is filed, the period of B Delay ends of the date the patent issues. In this case, a RCE was filed January 4, 2010. Per 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include "any time consumed by continued examination of the application requested by the applicant under section 132(b)."

37 CFR 1.703(b)(1) provides:

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued;

As stated above, the date on which a RCE was filed is not included in the B Delay period. The maximum B Delay in this case is 1062 days, which is the number of days beginning on February 7, 2007, the day after the date three years after the application's filing date, and ending on January 3, 2010, the day before the date the RCE was filed.

Patentees' determination of the B delay period fails to properly calculate the time excluded from B delay due to appellate review. The period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). An appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal. See 35 U.S.C. 134(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination). In this instance the period consumed by appellate review is 114 days, beginning on November 27, 2007, the date of filing of the notice of appeal and ending on March 19, 2008, the subsequent date of the mailing of a non-final Office action. The mailing of a Notice of Panel Decision from Pre-Appeal Brief Review is not the same as an Office action on the merits. The December 20, 2007 Notice withdrew the rejection and informed applicants that a new Office action would be mailed at some point in the future.

Considering the excluded period, the Office has determined that there are 26 days of overlap. Thus, B delay is 922 (1062 - 114 - 26) days.

In light of the above, the patent term adjustment remains 1590 days, which is the sum of 739 days of A delay and 922 days of B delay, reduced by 71 days of applicant delay.

It is noted that the Office issued a Notice of proposed rulemaking entitled *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements*, 76 FR 18990 (April 6, 2011). To the extent that the final rule on *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review* revises the interpretation of appellate review applied in this decision, Patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the date of the final rule to file a

request for reconsideration. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.

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